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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,724	12/17/1999	TADASHI WATANABE	0020/K-210(K)	1534

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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 04/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,724

Applicant(s)

WATANABE ET AL.

Examiner

Monique R Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-32 is/are pending in the application.
- 4a) Of the above claim(s) 27,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The request filed on 2/3/03 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/466724 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment filed 2/3/03 has been entered. New claims 28-32 have been added. Claims 10-32 are pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Newly submitted claims 31-32 depend on Claim 27 which was withdrawn for the reasons recited in the prior office action, hence Claims 31-32 are also withdrawn from consideration.

Claim Rejections - 35 USC § 102

5. Claims 10-11, 13, 15, 17, 19-26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Luch (USPN 4,101,385) for the reasons recited in the prior office action and restated below wherein the Examiner takes the position that the electrodeposited metal coating taught by Luch reads upon the claim limitation "electrodeposited paint" given that the instant disclosure does not define the term "paint" as resin containing paints only.
6. Luch teaches a process for making a metal plastic structure for use in automobiles such as for use as automobile bumpers utilizing a highly advantageous platable plastic composition comprising in percent by weight about 62% polymer, about 33% carbon black (*an inherently conductive substance*), about 0.7% elemental sulfur, about 0.7% mercaptobenzothiazyl disulfide and about 3% zinc oxide (*inherently conductive*) or other platable plastic composition known in the art, that is melt blended, then sheeted to form sheets having thicknesses in the range of about

Art Unit: 1773

100 to 2000 microns, and the thus formed platable plastic sheet is then mechanically applied under heat and pressure with or without a cement (*adhesive*) to a roughened, formed aluminum or aluminum alloy surface in such a fashion that the resultant aluminum-platable plastic is mechanically locked together (*as in instant claims 10-11, 13,15,21-26, Abstract; Col. 1, lines 5-42; Col. 1, line 64-Col. 2, line 9.*) Luch also teaches that the platable (*conductive*) plastic surface is then plated with “electrodeposited paint” wherein the platable article acts as a cathode in a plating bath such as in a nickel plating bath in such fashion that voltage is gradually increased until the whole plastic surface is covered with electrodeposited nickel that may further be covered by an electrodeposited layer of chromium or copper or nickel alloys wherein Luch specifically teach an example with a nickel electrodeposited layer of 3 microns followed by a copper electrodeposited layer of about 10 microns and further teaches that the platable composite can be plated according to known methods (*as in instant claims 15, 17 and 19-20; Col. 1, lines 45-48; Col. 2, lines 10-23; Example.*)

7. Claims 10, 15, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lo (USPN 4,745,012) for the reasons recited in the prior office action and restated below.

8. Lo teaches a process for producing an electrocoated multi-material workpiece such as an automobile body comprising the steps of first precoating a non-conductive, polymeric component or substrate with an electroconductive primer which is conductive when cured into a film thereby rendering the surface of the polymeric component sufficiently conductive for electrocoating, assembling the primed polymeric components with the conductive metallic components to form the multi-material workpiece, such as an automobile chassis 10, and then submerging the formed workpiece in an electrocoat bath 20 containing an electrocoating material

Art Unit: 1773

22 of the type and utilizing electrocoat techniques known to those skilled in the electrocoat arts to form an electrocoated multi-material workpiece; wherein in automotive embodiments, the polymeric component may comprise bumper components such as the rear or front bumper or bumper facia, automobile interior trim work, spoilers, fenders, door panels, or steering column components (Abstract; Figure 1, Col. 1, lines 9-50; Col. 1, line 61-Col. 2, line 15; Col. 3, lines 6-44; Col. 3, line 60-Col. 4, line 39.) Lo further teaches throughout the document that the conductivity of the primer directly affects the electrocoating properties of the non-conductive polymeric components wherein sufficient conductivity is required to provide the desired electrical properties for the electrocoating process and specifically teaches examples having a specific resistance within the instantly claimed range (Col. 5, lines 11-34; Examples.)

Claim Rejections - 35 USC § 103

9. Claims 11, 12, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luch. The teachings of Luch are discussed above. Luch does not specifically teach that the platable plastic film has a thickness in the range of 1 to 100 μ m or 3 to 75 μ m, or that the electrodeposited paint film has a thickness of about 10 to about 40 μ m or about 10 to about 20 μ m, however given that thickness is a known result-effective variable affecting the mechanical properties of the resulting composite, it would have been obvious to one having ordinary skill in the art to utilize routine experimentation to determine the optimum thickness of the plastic film as well as the protective plating layer to provide the desired mechanical properties of the composite material taught by Luch for a particular end use.

10. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luch '385 in view of Luch (USPN 3,865,699) or Luch (USPN 4,009,093). The teachings of Luch

Art Unit: 1773

'385 are discussed above and include the use of platable plastic compositions as taught in Luch '699 or Luch '093 (Col. 1, lines 34-37.) Though Luch '385 does not specifically teach the volume specific resistance or the surface resistance of the platable plastic compositions, it is well known in the art that conductivity or electrical resistance, measured as volume specific or surface resistance, are known result-effective variables in terms of an electrodeposition process as taught by Luch '385 wherein Luch '699 (Col. 2, lines 22-35; Col. 4, line 16-Col. 5, line 13) and Luch '093 (Col. 2, lines 23-36; Col. 4, line 14-Col. 5, line 11) teach that the plastic composition preferably has a volume resistivity of less than 1000 ohm-cm in order to provide the desired electrical properties for electroplating wherein the plated object may be subjected to further electrodeposition in ways well known to those skilled in the art. Hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a platable plastic composition having a volume specific resistivity of less than 1000 or 10^3 as taught by Luch '699 or Luch '093 for the invention taught by Luch '385 or to utilize routine experimentation to determine the optimum conductivity or resistivity as measured as volume specific resistance and/or surface resistance, to provide the desired electrical properties for the electrodeposition process taught by Luch '385.

11. Claims 10-13, 15, 17-26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luch '385 in view of the admitted prior art or Midoguhchi et al (USPN 5,483,012) or Horibe et al (6,231,984) for the reasons recited in the prior office action and restated below.

12. The teachings of Luch '385 are discussed above. Though Luch teaches that the platable plastic-metal composite is further coated with an electrodeposited decorative plating layer, Luch

Art Unit: 1773

does not teach utilizing the electrodeposition paint as recited in instant claim 18 or an electrodeposition resin paint as instantly claimed. However, the admitted prior art at Page 9, line 18-Page 10, line 12, teach that electrodeposition paints as in claim 18 are known in the art wherein Midogohchi et al, cited at Page 9, line 23 of the instant disclosure, specifically teach the use of a cationic electrodepositable coating composition as instantly claimed to provide improved chip resistance and corrosion resistance to steel automotive panels wherein the thickness of the cationic electrodepositable coating composition is not specifically limited and is in the range of 10 to 50 μ m, preferably 15 to 35 μ m (Abstract; Col. 2, lines 47-53; Col. 4, lines 18-28; Col. 7, lines 9-54; Col. 8, lines 1-4.) Horibe et al also teach the use of a cationic electrodeposited coating film as instantly claimed as a corrosion resistant component of a multilayer coating film on an automotive part or body such as a fender wherein the coating layer thickness is preferably 10-40 μ m, particularly 15-30 μ m (Abstract; Col. 1, line 66-Col. 3, line 63.) Hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any cationic electrodepositable coating composition conventionally utilized for coating automotive parts wherein a cationic electrodeposited paint containing a base resin having a hydroxyl group and an amino group which can be converted to a cation with an aliphatic block polyisocyanate compound is taught by Midogohchi et al or Horibe et al to provide improved chip resistance and/or corrosion resistance to the metal automotive substrate taught by Luch '385.

13. Claims 11, 12, 14, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in further view of Luch '699, Luch '093, or Palaika et al for the reasons recited in the prior office action and restated below.

Art Unit: 1773

14. The teachings of Lo are discussed above. Lo does not teach that the thickness of the plastic components or substrates or the thickness of the electrodeposited paint film as instantly claimed, however, given that thickness is a known result-effective variable affecting the mechanical properties of the resulting composite, it would have been obvious to one having ordinary skill in the art to utilize routine experimentation to determine the optimum thickness of the plastic film as well as the protective plating layer to provide the desired mechanical properties of the composite material taught by Lo for a particular end use. Further, Lo does not specifically teach the volume specific resistance or the surface resistance ranges as instantly claimed, however Lo does teach that conductivity or electrical resistance is a result-effective variable in terms of an electrocoating process which is further evidenced by Luch '699 or Luch '093 or Palaika et al, all of which specifically teach resistance range values as instantly claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize routine experimentation to determine the optimum conductivity or electrical resistance to provide desired electrical properties for electrocoating the invention taught by Lo.

15. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of the admitted prior art or Midoguhchi et al (USPN 5,483,012) or Horibe et al (6,231,984) for the reasons recited in the prior office action and restated below.

16. The teachings of Lo are discussed above. Though Lo teaches that the electrocoated workpiece can be producing using an electrocoating material 22 of the type and utilizing electrocoat techniques known to those skilled in the electrocoat arts to form the electrocoated multi-material workpiece, Lo does not specifically teach that the electrocoating material is a cationic electrocoating material, however, a cationic electrocoating material or paint is a known,

Art Unit: 1773

conventional and obvious species of electrocoating materials or paints utilized in the automotive industry as evidenced by the admitted prior art or Midoguhchi et al or Horibe et al and would have been obvious to one having ordinary skill in the art at the time of the invention based on the teachings of Lo. Further, the admitted prior art at Page 9, line 18-Page 10, line 12, teach that electrodeposition paints as in claim 18 are known in the art wherein Midogohchi et al, cited at Page 9, line 23 of the instant disclosure, specifically teach the use of a cationic electrodepositable coating composition as instantly claimed to provide improved chip resistance and corrosion resistance to steel automotive panels wherein the thickness of the cationic electrodepositable coating composition is not specifically limited and is in the range of 10 to 50 μ m, preferably 15 to 35 μ m (Abstract; Col. 2, lines 47-53; Col. 4, lines 18-28; Col. 7, lines 9-54; Col. 8, lines 1-4.) Horibe et al also teach the use of a cationic electrodeposited coating film as instantly claimed as a corrosion resistant component of a multilayer coating film on an automotive part or body such as a fender wherein the coating layer thickness is preferably 10-40 μ m, particularly 15-30 μ m (Abstract; Col. 1, line 66-Col. 3, line 63.) Hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any cationic electrodepositable coating composition conventionally utilized for coating automotive parts wherein a cationic electrodeposited paint containing a base resin having a hydroxyl group and an amino group which can be converted to a cation with an aliphatic block polyisocyanate compound is taught by Midogohchi et al or Horibe et al to provide improved chip resistance and/or corrosion resistance to the metal automotive workpiece taught Lo.

17. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Luch '385 for the reasons recited in the prior office action and restated below.

Art Unit: 1773

18. The teachings of Lo are discussed above. Though Lo teaches that the non-conductive polymeric components or substrates, such as bumper facia or components, are first precoated with a conductive primer and then assembled with the conductive metallic components to form the multi-material workpiece, such as an automobile body, Lo does not teach that the primed polymeric components are adhered to the metallic components using an adhesive. However, the use of an adhesive to provide a more secure and permanent bond between assembled components is conventional and well known in the art and would have been obvious to one having ordinary skill in the art at the time of the invention. Further, Luch '385 teaches a multi-material component such as an automobile bumper comprising a polymeric component and a metal component wherein Luch '385 specifically teaches that the two materials are mechanically attached to one another with or without a cement to form the automotive bumper.

Response to Arguments

19. Applicant's arguments filed 2/3/03 have been considered but are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., electrodeposited resin paint film) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hence, the limitation "electrodeposited paint" in its broadest sense includes any electrodeposited coloring layer including the electrodeposited metal layers taught by Luch '385. Further, in response to applicant's arguments against the references individually, one cannot show nonobviousness by

Art Unit: 1773

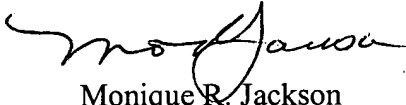
attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). With regards to the Lo reference, the Applicant argues that Lo does not teach a preformed film adhered to the metal plate however, the Examiner takes the position that the limitation with regards to the preformed film is a process limitation that does not materially affect the final product. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985.) Hence, given that the product taught by Lo comprises the same layers as the instant invention, it appears to be the same product as the instantly claimed invention and hence reads on the rejected claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'Monique R. Jackson', written in a cursive style.

Monique R. Jackson
Primary Examiner
Technology Center 1700
April 21, 2003